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FINNEGAN, HENDERSON, FARABOW GARRETT & DUNNER, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			BORISOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/024,622	GIACCHETTI ET AL.
	Examiner	Art Unit
	Igor Borissov	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 9/03/2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-61 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-61 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Response to Amendment

Amendment received on 9/03/2004 is acknowledged and entered. Claims 32, 39 and 49 have been amended. New claims 53-61 have been added. Claims 1-61 are currently pending in the application.

Claim Objections

Claim 26 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. See MPEP § 608.01(n). Accordingly, the **claim 26** has not been further treated on the merits.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 32-47, 49-53 and 57-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method for providing guidance for a subject does not recite a limitation in the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that

promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the decision of *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447, 1449-50 (Fed. Cir. 1999), it was recognized that not everything is statutory subject matter. The court noted that a mathematical algorithm or abstract idea is directed to

non-statutory subject matter unless applied in a useful way or otherwise reduced to some type of practical application. The analysis in the *AT&T Corp* decision focused on whether or not the claimed mathematical algorithm was used to produce a useful, concrete and tangible result. AT&T's claimed process employs subscribers' and call recipients' primary interexchange carrier (PIC) indicator as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through switching and recording mechanisms to create a signal useful for billing purposes. The court noted that PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber, and therefore, found the claimed process to comfortably fall within the scope of Section 101. *AT&T Corp.*, 50 USPQ2d 1453. Again, *AT&T Corp.* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the court in *AT&T Corp.* recognized that the claims require the use of switches and computers. In *AT&T Corp.*, the decisions of *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1060, 22 USPQ2d 1033,1039 (Fed. Cir. 1992) were also cited. In *Alappat* it was held that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a smooth waveform display. In *Alappat*, the claimed invention was for a machine that achieved certain results and was therefore, already considered to involve the technological arts. In *Arrhythmia*, the court reasoned that the method claims qualified as statutory subject matter by noting that the steps transformed physical, electrical signals from one form into another form – a number representing a signal related to the patient's heart activity, a non-abstract output.

This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

The claims of the present application are distinguished from the claims analyzed in the decisions of *State Street*, *Alappat*, *Arrhythmia* and *AT&T*, where the claims in these cases clearly involved the use of technology as shown below.

State Street: The claims were in means plus function form and directed to a data processing system for managing a financial services configuration of a portfolio established as a partnership; the claims included limitations of a computer processor means for processing data, a storage means for storing data on a storage medium along with first through fifth means for processing different types of financial data. As such, the claims analyzed in *State Street* clearly involved the technological arts and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

AT&T Corp: The claims were directed to a method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber comprising generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. In considering these claims, it is clear that technology is being used to "automatically route" calls over the facilities of interexchange carriers and generating a message record for the call. Furthermore, the courts, in analyzing these claims, clearly indicated that they recognized the claims require the use of switches and computers. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1450 (Fed. Cir. 1999). The court further noted that AT&T's claimed process employs subscriber's and call recipients' PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through *switching and recording mechanisms* to create a signal useful for billing purposes. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1453 (Fed. Cir. 1999). As such, the claims analyzed in AT&T clearly involved the technological arts as recognized

by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Alappat: The claims were directed to a rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising various means for determining distances and means for outputting illumination intensity data. Alappat's invention related generally to a means for creating a smooth waveform display in a digital oscilloscope and as indicated by the court, Alappat's invention is an improvement in an oscilloscope comparable to a TV having a clearer picture. The court reasoned that invention was statutory because the claimed invention was directed to a "machine". See *In re Alappat*, 31 USPQ2d at 1552-54 (Fed. Cir. 1994). Furthermore, in the decision of *AT&T Corp.*, the courts recognized that the claims in Alappat were for a machine that achieved certain results. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 50 USPQ2d at 1452 (CAFC 1999). Once again, these claims clearly involve the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Arrhythmia: The claims were directed to a method for analyzing electrocardiograph signals to determine the presence or absence of a predetermined level of high frequency energy in the late QRS signal including the step of converting a series of QRS signals to time segments, each segment having a digital value equivalent to the analog value of said signals at said time. In considering these claims, it is clear that technology is being used to convert a series of QRS signals to time segments having a digital value. Once again, these claims clearly involve the technological arts since one could not convert a signal to a time segment having a digital value without the aid of a computer or some processing device and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Contrary to the claims in the above-cited cases, in the present application, **claims 1-4, 32-47, 49-53 and 57-61** are completely silent with regard to technology and is purely an abstract idea or process steps that are employed without the use of any

technology. The claims are no more than a suggested idea of allowing a customer to see how she/he looks after the customer used a beauty product. The mere fact of *obtaining information and facilitating storage of information* does not provide a useful, concrete and tangible result.

Furthermore, the examiner submits that there are absolutely no limitations included in this claim that would suggest a computer or data processing device is being used to carry out the processes. The independently claimed steps of: *obtaining first information representative of an external body condition of a subject; obtaining second information representative of the external body condition of the subject after the subject uses a beauty product; facilitating storage of information reflecting the subject's usage of the beauty product; and enabling the subject to view the first information, the second information, and at least part of the stored information* are abstract ideas which can be performed mentally without interaction of a physical structure. Said method steps may be understood as merely providing a sketch of a human face for getting assistance in a beauty store. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Although Bowman is not precedential, it has been cited for its analysis.

Moreover, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not recite any physical transformation of data whatsoever. The claims merely recite obtaining and storing information steps. Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

As per “instructing” method steps, the term *instructing* does not provide or indicate any technology, and may be understood as merely explaining a beauty facility employee how to capture images of the external body condition.

As per “enabling” method steps, the term *enabling* does not provide or indicate any technology, and may be understood as merely instructing a subject how to record beauty information on a transportable medium, such as a sheet of paper.

Because the independently claimed invention is directed to an abstract idea which does not provide practical applications, and does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24, 27, 29-30, 32-38, 45, 48, 50 and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al. (US 2002/0054714).

Hawkins et al. (hereinafter Hawkins) teaches a method and system for evaluating cosmetic product on a consumer, comprising:

Independent Claims.

Claim 1. Capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the

consumer [0041]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing* of the transformed information) [0044]; displaying captured and transformed images to the user [0044].

Claims 5 and 48. Selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the user [0044].

Claim 32. Selecting a cosmetic product and capturing an image of a body feature before and after application of the cosmetic product at a sales counter (*beauty facility*) [0039]; [0053]; and displaying captured and transformed images to the user [0044]. Selecting the cosmetic product at the sales counter (*beauty facility*) inherently indicates *distributing* said cosmetic product to the point of sale. Also, use of said method, disclosed by Hawkins, inherently indicates *instructing* a business entity to perform said method steps.

Claim 50. Selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering a cosmetic product based on the results [0053].

Dependent Claims.

Claims 2-3. See claim 1.

Claim 4. Said method and system, wherein obtaining information occurs over the Internet [0053].

Claims 6-9. Said method and system, wherein a cosmetic product is offered at the point-of-sale [0053].

Claim 10. Said method and system, wherein enabling electronic capturing of at least one of the first and second first images includes providing the beauty facility with an image capture device [0053].

Claim 11. Said method and system, wherein access to the image capture device is provided over the Internet [0053].

Claim 12. Said method and system, wherein the external body condition is a skin condition of the subject's face [0046].

Claims 13-14. See claim 32.

Claim 15. See claim 5.

Claim 16. See claim 5.

Claim 17. See claim 5.

Claim 18. Displaying original and transformed images side-by-side to the consumer so that the consumer forced to pick one image [0044].

Claims 19-20. Providing a kit for displaying a consumer's skin images, said kit including a camera and a programmable device [0026], thereby inherently indicating providing necessary software (*driver*) for the system to operate.

Claims 21-22. See claim 5.

Claim 23. Said method and system, wherein said cosmetic product is offered to the consumer at a retail terminal [0053]. Information as to *is the retailer a manufacturer, reseller or wholesaler* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 24. Displaying a consumer's skin images on a computer monitor [0026] inherently indicates use of a *tangible recording media*.

Claim 27. Communications via the Internet inherently indicates viewing said images at locations remote from the beauty facility [0053].

Claim 29. See claim 5.

Claim 30. See claim 27.

Claim 33. Capturing images at the beauty facility [0053] inherently indicates providing "know-how" for said capturing to the beauty facility.

Claims 34-36. Providing a kit for displaying a consumer's skin images, including a camera and a programmable device [0026], inherently indicates providing necessary software for the system to operate.

Claim 37. See claim 34.

Claim 38. A cosmetic product is selected for a trial for a consumer before each image is recorded [0013]; [0014].

Claim 54. Displaying to the subject side by side an original image and a digitally transformed image of the subject's face to demonstrate effects (effectiveness) of a cosmetic product treatment [0044].

Independent claim 45 is rejected under 35 U.S.C. 102(e) as being anticipated by Maloney et al. (WO 01/18674 A2).

Claim 45. Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising: providing by the consumer information about consumer's cosmetic product usage and lifestyle (page 7, lines 1-2); obtaining feedback from the consumer (*update*) for the cosmetic products offered (page 12, lines 15-16); based on the collected and updated information recommending a cosmetic product to the consumer (page 12, lines 15-16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Dependent claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins.

Claim 28. Hawkins teaches that capturing of the consumer's first and second images may be provided either in the beauty facility, or user's home (*location remote from the beauty facility*), and that the communication between the beauty facility and the consumer may be conducted over the Internet [0053].

However, Hawkins does not specifically teach that after the *first* image is taken in the beauty facility, the consumer is *recommended* to capture the *second* image at the *location remote from the beauty facility*.

It is old and well known that if some task can be performed at home rather than at the remote facility, it is convenient to perform said task at home.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include *recommending* the consumer to take the second image at home, because it would be convenient for the consumer to take the second image at the time suitable for the consumer.

Dependent claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of AS/400 Redbook Softcopy Library, an image of a CD (Document).

Claim 25. Hawkins teaches: displaying a consumer's skin images on a computer monitor [0026], thereby inherently indicating use of a *tangible recording media*.

However, Hawkins does not teach that said tangible recording media includes a *visible marking* identifying a distributor.

Document discloses an image of a CD (which appears to be released in June, 1995), containing a *visual depiction* of a manufacturer/distributor (IBM).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include that said tangible recording media

includes a *visible marking* identifying a distributor, because it would promote distributor's products.

Claims 39-44 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney.

Independent Claims.

Claim 39. Maloney teaches: providing a subject with a image capturing device for recording and displaying personal beauty information including an image of a subject (page 20, lines 27-28; page 26, claim 20); wherein said recording and displaying obviously indicates recording said information on a computer-readable media. Furthermore, Maloney teaches that said recorded information could be read at beauty facilities (a central location or kiosks) and obviously updated (page 11, line 17-18; page 15, lines 4-6). Providing the subject with image capturing device at home obviously indicates updating said personal beauty information at a location remote from the beauty facility.

Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media.

However, it is old and well known that computer-readable media can be a transportable. For example, Maloney teaches floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

Claim 44. Maloney teaches: recording, at beauty facilities (a central location or kiosks), personal beauty information of a subject, including an image of the subject (page 11, line 17-18; page 26, claim 20); wherein said recording and displaying obviously indicates recording said information on a computer-readable media.

Furthermore, Maloney teaches that said recorded information can be accessed by the subject from home (remotely from the beauty facilities) (page 11, lines 13-14; page 6, lines 30-33); wherein providing the subject with image capturing device at home obviously indicates updating said personal beauty information at a location remote from the beauty facility. Furthermore, Maloney teaches allowing the subject to compare original and updated personal beauty information (page 20, lines 27-34).

Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media.

However, it is old and well known that computer-readable media can be a transportable. For example, Maloney teaches floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

Dependent Claims.

Claim 40. Providing the subject with image capturing device at home obviously indicates updating step at a remote location (See reasoning applied to **claim 39**).

Claims 41-43. See reasoning applied to **claim 39**.

Claim 58. Maloney teaches: providing by the consumer personal beauty information (page 7, lines 1-2); wherein said information is provided on a transportable medium (a floppy diskette or compact disc, a handwritten questionnaire (page 13, line 31; page 6, line 32) or a digital camera (page 26, claim 20).

Claim 59. Maloney teaches: enabling a beauty facility (a central location or a kiosk) to record on transportable medium personal beauty information relating to beauty habits (page 6, line 32; page 7, lines 1-2; page 11, line 17; page 15, line 5; page 17, line 33).

Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2002/0077219) in view of Maloney.

Independent Claim.

Claim 46. Cohen et al. (hereinafter Cohen) teaches a method and system for offering a health-related product for a consumer based on determined lifestyle, wherein price for the health-related product (exercise equipment) is determined based on estimated trend of usage of said product and lifestyle of the product users.

However, Cohen does not specifically teach that said product is a *cosmetic* product:

Maloney teaches said method and system for providing a customized *cosmetic* product combination to a consumer, wherein said cosmetic product is offered based on historical usage information of said product and lifestyle (page 7, lines 1-2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cohen to include that said product is a *cosmetic* product, as disclosed in Maloney, because it would advantageously expand a line of products and bring more customers to the business, thereby increase revenue.

Dependent Claim.

Claim 47. Enabling the subject to record personal information about the subject's physical characteristics, and wherein the caused at least one product recommendation is a function of the subject's lifestyle and physical information (Maloney; lines 1-2).

Claims 31, 49, 51-53 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Maloney.

Independent Claims.

Claim 31. Hawkins teaches: Selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been

applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the user [0044]. Hawkins does not specifically teach prescribing a cosmetic product.

Maloney teaches: providing personal information associated with the subject including capturing an image of the subject; providing virtual image of the subject to demonstrate (determine) a result of use of a cosmetic product; and providing the consumer with a list of products which should achieve the desired look (page 20, lines 27-34; page 26, claim 20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include recommending a list of products which should achieve the desired look based on the determined differences, as disclosed in Maloney, because it would advantageously allow the consumer to achieve the desired look.

Claim 49. Hawkins teaches: selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering a cosmetic product based on the results [0053]. Hawkins does not specifically teach prescribing at least one beauty product based on the determined differences.

Maloney teaches: providing personal information associated with the subject including capturing an image of the subject; providing virtual image of the subject to demonstrate (determine) a result of use of a cosmetic product; and providing the consumer with a list of products which should achieve the desired look (page 20, lines 27-34; page 26, claim 20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include recommending a list of products which should achieve the desired look based on the determined differences, as

disclosed in Maloney, because it would advantageously allow the consumer to achieve the desired look.

Dependent Claims.

Claim 51. Hawkins teaches all the limitations of claim 51, except specifically teaching that the *consumer is enabled to maintain control through the use of software that stores the record at a location with access controlled by the consumer*.

Maloney teaches said method and system, wherein *access to the record containing personalized consumer data is enabled by entering consumer's username and password* (page 17, lines 12-13), thereby obviously indicating *controlling access to said data*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include that *access to consumer's personal data is controlled by the consumer*, as disclosed in Maloney, because it would advantageously enhance security of the system.

Claim 52. Said method and system, wherein the location is a portable information storage medium (Maloney; page 13, lines 29-30).

Claim 53. Displaying to the subject a digitally transformed image of the subject's face to demonstrate effects (effectiveness) of a cosmetic product treatment [0044].

Claim 55. Maloney teaches: providing personal information associated with the subject including capturing an image of the subject; providing virtual image of the subject to demonstrate (determine) a result of use of a cosmetic product; and providing an advice to the subject based on said personal information associated with the subject and said result (page 20, lines 27-34; page 26, claim 20). The motivation to combine Hawkins and Maloney would be to advantageously allow the consumer to achieve the desired look.

Claim 56. Hawkins teaches all the limitations of claim 56, except specifically teaching presenting to the subject the determined probable cause along with

preventative measures. Maloney teaches: providing personal information associated with the subject including capturing an image of the subject; after the subject alters the image to produce the desired look, providing the subject with a list of products which should achieve the desired look (page 20, lines 27-34). The motivation to combine Hawkins and Maloney would be to advantageously allow the consumer to achieve the desired look.

Claim 57. See reasoning applied to claim 55.

Claim 60. See reasoning applied to claim 49.

Claim 61. See reasoning applied to claim 56.

Response to Arguments

Applicant's arguments filed 9/03/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that **claims 1-4, 32-47, 49-53 and 57-61** include technical limitations, and therefore provide "a concrete, tangible and useful results", the examiner stipulates that **claims 1-4, 32-47, 49-53 and 57-61** are completely silent with regard to technology and is purely an abstract idea or process steps that are employed without the use of any technology. The mere fact of *obtaining information and facilitating storage of information* does not provide a useful, concrete and tangible result.

Furthermore, the examiner submits that there are absolutely no limitations included in this claim that would suggest a computer or data processing device is being used to carry out the processes. The independently claimed steps of: *obtaining first information representative of an external body condition of a subject; obtaining second information representative of the external body condition of the subject after the subject uses a beauty product; facilitating storage of information reflecting the subject's usage of the beauty product; and enabling the subject to view the first information, the second information, and at least part of the stored information* are abstract ideas which can be

performed mentally without interaction of a physical structure. Said method steps may be understood as merely providing a sketch of a human face for getting assistance in a beauty store. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Although Bowman is not precedential, it has been cited for its analysis.

In accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not recite any physical transformation of data.

Therefore, so as the independently claimed invention is directed to an abstract idea which does not provide practical applications, and does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter.

In response to applicant's argument that Hawkins images fail to teach reflecting the subject's usage of a beauty product, it is noted that Hawkins explicitly teach this feature. Specifically, Hawkins teaches: capturing an image of the body before and after the product has been applied, and allowing to compare results between captured images [0039]-0042].

In response to applicant's argument that Hawkins does not teach a *prescribing* step, it is noted that Maloney was applied for this feature (page 20, lines 27-34).

In response to applicant's argument that Hawkins does not teach *analyzing first and second information to determine an extent of differences that occurred in the body*

condition, it is noted that Hawkins specifically teach allowing the consumer to compare results between images to demonstrate effects of cosmetic treatments [0042]; [0044].

In response to applicant's argument that Hawkins does not disclose *instructing* feature, the examiner points out that he understands the instructing feature as providing instruction recorded on the computer-readable media to perform method steps recited in the claims. Hawkins discloses a computer-implemented method, wherein the method steps disclosed are conducted by executing by a computer instructions provided on a computer-readable media.

In response to applicant's argument that there is no motivation to modify Hawkins to include *recommending* feature, it is noted that the motivation to modify Hawkins to include that after the *first* image is taken in the beauty facility, the consumer *is recommended to capture the second image at location remote from the beauty facility, for example at home*, would be to advantageously allow the consumer to take the second image at any suitable time for the consumer.

In response to applicant's argument that Maloney does not teach that profiling data contains *product usage information*, it is noted that Maloney teaches that personalized data supplied by the consumer includes purchasing choices made by the consumer; the type of products, preferred colors and styles, lifestyle (page 7, lines 1-2; page 17, lines 32-33).

In response to applicant's argument that the prior art does not teach that said personal beauty information is recorded on the *transportable* media, the examiner points out that Maloney teaches: providing a subject with a image capturing device for recording and displaying personal beauty information including an image of a subject (page 20, lines 27-28; page 26, claim 20); wherein said recording and displaying obviously indicates recording said information on a computer-readable media.

Furthermore, Maloney teaches that a computer-readable media can be a floppy

diskette, compact disc or laser disc (page 13, lines 31-32). The motivation to modify Maloney to include that said personal beauty information is recorded on a *transportable* media would be to advantageously allow employing this method in geographical locations where network communication is not available.

In response to applicant's argument that the prior art does not teach enabling a *beauty facility to record on transportable medium* personal beauty information about a subject, it is noted that Maloney teaches: recording, at beauty facilities (a central location or kiosks), personal beauty information of a subject, including an image of the subject (page 11, line 17-18; page 26, claim 20); wherein said recording and displaying obviously indicates recording said information on a transportable computer-readable media (See reasoning above).

In response to applicant's argument that Cohen is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Cohen and Maloney relate to offering a health-related product for a consumer based on historical usage information of said product and a lifestyle. The health related product in Cohen is exercise equipment. The motivation to modify Cohen to include that said health-related product includes also a cosmetic product, as disclosed in Maloney, would be to expand a line of products and bring more customers to the business, thereby increase revenue.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

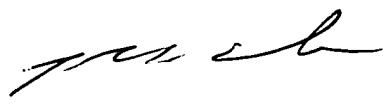
Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


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11/26/2004